

Applicant : Pilarski et al
Serial No. : 10/672,399
Filed : 09/25/2003
Page : 12 of 15

Attorney's Docket No: 05-013

REMARKS

Claim Amendments

Claim 21 has been amended to incorporate the specific HAS1 isoenzyme variants HAS1Va, HAS1Vb, HAS1Vc detected through the claimed method.

Claim 49 has been amended to incorporate the specific HAS1 isoenzyme variants HAS1Va, HAS1Vb, HAS1Vc.

Claim 88 has been amended to incorporate the specific HAS1 isoenzyme variants HAS1Va, HAS1Vb, HAS1Vc.

No new matter has been added by these amendments. The Examiner is hereby requested to enter these amendments.

Applicants submit that all claim amendments presented herein or previously are made solely in the interest of expediting allowance of the claims and should not be interpreted as acquiescence to any rejections or ground of unpatentability. Applicants reserve the right to file at least one continuing application to pursue any subject matter that is canceled or removed from prosecution due to the amendments.

Rejections Under 35 U.S.C. §112, Enablement (Page 3, Paragraph 1 –Page 5 Paragraph 2)

The rejection of claims 21, 23, 27, 49-50 and 88-90, under 35 U.S.C. §112, first paragraph, as allegedly not being enabled, have been obviated for the reasons set forth below.

Applicant : Pilarski et al
Serial No. : 10/672,399
Filed : 09/25/2003
Page : 13 of 15

Attorney's Docket No: 05-013

The test of enablement is whether one skilled in the art could make or use the invention from the disclosures coupled with information known in the art without undue experimentation. MPEP §2164.01; *United States v. Telectronics, Inc.* 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). Within the present application, the applicant explicitly defines the term "isoenzyme variants", specifically as a "protein resulting from the alternation of the native HAS isoenzyme arising from post-translational or pre-translational modification". It is respectfully submitted that the phrase "HAS1 isoenzyme variants" is not a "laboratory designation". Notwithstanding, reference is made to the particular sequence identifiers in the relevant claims.

Rejections Under 35 U.S.C. §102(b) Anticipation (Page 5, Paragraphs 3– Page 6, Paragraph 3)

The rejection of claims 88 and 90 under 35 U.S.C. §122(b), as allegedly being anticipated by Adamia et al., have been obviated for the reasons set forth below.

Adamia et al represents the Applicants own authored publication and disclosure. As the reference was made available to the public, less than one year prior to the effective filing date of the present application (which is not admitted, nor evident), the publication is not a statutory bar under 35 U.S.C. 102(b) or U.S.C. 103. Therefore the rejection of claims 88 and 90 as being anticipated is obviated

The rejection of claims 49-50 and 88-89 under 35 U.S.C. §122(b), as allegedly being anticipated by Calabro et al., have been obviated for the reasons set forth below.

The examiner quotes Calabro et al as stating "HAS1 isoenzyme variant mRNA is expressed predominantly in the myeloma bone marrow plasma cells from MM patient compared with normal bone marrow cells". Respectfully, the Applicant has been unable to locate that quote anywhere within Calabro et al., nor has the Applicant been able to identify the general teaching therein.

Applicant : Pilarski et al
Serial No. : 10/672,399
Filed : 09/25/2003
Page : 14 of 15

Attorney's Docket No: 05-013

The word "variant" does not appear anywhere in the text of Calabro et al., nor do the contiguous DNA sequences or peptide sequences of HAS1Va, HAS1Vb, or HAS1Vc disclosed herein (ie. SEQ ID NO. 4, SEQ ID NO. 6, and SEQ ID NO. 8). Calabro et al. does not teach the concept of a HAS1 isoenzyme variant, the isoenzyme variant being a "protein resulting from the alteration of a native HAS isoenzyme arising from post-translational or pre-translational modification" (present application, paragraph 0110). Calabro et al. discusses the native HAS isoenzymes, specifically HAS1 and HAS2, and does not address variants of said isoenzymes, for example HAS1Va, HAS1Vb and HAS1Vc. Both the protein structure and translated RNA of the isoenzyme variants disclosed in the present application, are different in composition and activity from the isoenzymes previously known in the art (HAS1 and HAS2). It is respectfully submitted that the nomenclature of "isoenzyme variants" or "HAS1Va", "HAS1Vb", and "HAS1Vc" are not a vague or indefinite phrase, as used in the present application, as these terms are explicitly defined within the present application, see for example paragraphs 0110, 059, 060 and 061.

Conclusions.

For the reasons set forth above, Applicants submit that the claims of this application are patentable. Reconsideration and withdrawal of the Examiner's objections and rejections are hereby requested. Allowance of the claims remaining in this application is earnestly solicited.

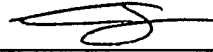
In the extent that a telephone conversation could expedite the prosecution of this application, the Examiner is requested to call the undersigned at (403) 689-2934.

Applicant : Pilarski et al
Serial No. : 10/672,399
Filed : 09/25/2003
Page : 15 of 15

Attorney's Docket No: 05-013

Respectfully submitted,

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Craig K Sherburne

Reg. No. 57,018

Craig K Sherburne Professional Corporation

#35, 1011 Canterbury Drive SW

Calgary, Alberta

Canada, T2W 2S8

Telephone: (403) 689-2934

Facsimile: (403) 281-1472